



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,098	09/09/2004	Emilio A Emini	21050YP	9083
210 7590 06/13/2007 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907			EXAMINER BLUMEL, BENJAMIN P	
			ART UNIT 1648	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,098

Applicant(s)

EMINI ET AL.

Examiner

Benjamin P. Blumel

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4,12,18,19,21-23,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13-17,20 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of the species Adenovirus serotype 5 and ALVAC in the reply filed on May 4, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 4, 12, 18, 19, 21-23, 28 and 29 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 4, 2007.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1648

Claims 1, 2, 6-9, 14-17, 20 and 24-27 rejected under 35 U.S.C. 102(e) as being anticipated by McMichael et al. (US 6,663,871 B1).

The claimed invention is drawn to a method of inducing an enhanced immune response against an HIV-1 gag antigen in a mammalian host. The method comprises administering a recombinant, replication defective Adenovirus of serotype 5 (Ad5) that expresses HIV-1 gag and has a deletion of the E1 gene, followed by the administration of a ALVAC virus that expresses the same antigen, HIV-1 gag. In the case of Ad5, the HIV gene is regulated by a CMV promoter devoid of intronic sequences.

McMicheal et al. teach a prime-boost method of vaccinating mice with recombinant Ad5 that expresses HIV gag antigen followed by the administration of MVA that also expresses the HIV antigen. McMichael et al. also discuss that NYVAC, ALVAC, fowlpox or other poxviruses can be utilized during the boost immunization, in place of MVA. The Ad5 utilized by McMicheal et al. lacks the E1 gene and contains a CMV Immediate/Early promoter that regulates HIV gag expression. The various poxviruses disclosed by McMichael et al. possess a replication-impaired phenotype with regard to proliferation in a mammalian host.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1648

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 5, 10, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMichael et al. as applied to claims 1, 2, 6-9, 14-17, 20 and 24-27 above, and further in view of Emini et al. (US 6,733,993 B2).

One of the applied references has common inventors and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome

Art Unit: 1648

by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2).

The teachings of McMichael et al. are discussed above. However, McMichael et al. do not teach the specific deletion of the Ad5 genome between base pairs 451-3510, the modification of the HIV *gag* antigen with codons optimized for expression in a human, the claimed bovine hormone polyadenylation (polyA) and transcription termination sequence, or the use of a human CMV IE promoter.

Emini et al. teach the creation of a recombinant Ad5 that lacks the genomic region between base pairs 451-3510, the specific human CMV IE promoter without intronic sequences and optimized codons of the HIV *gag* antigen for expression in a human. Emini et al. also teach the use of a bovine hormone polyadenylation and transcription termination sequence in the recombinant Ad5.

It would have been obvious to one of ordinary skill in the art to modify the methods taught by McMichael et al. in order to vaccinate a host with a recombinant Ad5 lacking base pairs 451-3510 and expressing HIV *gag* protein with optimized codons, which is controlled by a human CMV IE promoter, followed by a recombinant ALVAC also expressing the HIV *gag*, thereby inducing an enhanced immune response to HIV *gag*. One would have been motivated to do so, given the suggestion by McMichael et al. that the method be used to enhance the immune response to antigens of pathogens, such as HIV *gag*. There would have been a reasonable expectation of success, given the knowledge that Ad5 has been engineered by deleting base pairs 451-3510, and also expressing codons optimized HIV *gag*, which is controlled by a human CMV IE that does not contain intronic sequences and also contains a bovine hormone polyA and

Art Unit: 1648

transcription termination sequences, as taught by Emini et al. Thus the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-11, 13-17, 20 and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed invention recites “A method for inducing an enhanced immunological response against an HIV-1 *gag* protein...”, however it is unclear what the “enhanced immunological response” is compared to in order to claim that the immune response is enhanced by administering the two difference viral vectors in a prime-boost method.

Summary

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin P. Blumel whose telephone number is 571-272-4960. The examiner can normally be reached on M-F, 8-4:30.

Art Unit: 1648

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-1600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



/Benjamin P Blumel/
Examiner
Art Unit 1648



BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600